



Paper No. 5

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MAR 14 2002

OFFICE OF PETITIONS

In re Application of
Dielhof, Centen & Morisson
Application No. 09/826,620
Filed: April 5, 2001
Attorney Docket No. NL000204
For: FRONT-END DEVICE FOR CCD WITH
HYBRID SAMPLER

:
: DECISION REFUSING
: STATUS UNDER
: 37 CFR 1.47(a)
:
:

This is a decision on the petition under 37 CFR 1.47(a), filed December 31, 2001.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on April 5, 2001 without an executed oath or declaration. Accordingly, on May 14, 2001, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on December 31, 2001 (certificate of mailing November 14, 2001), a petition for a four month extension of time with required fee, a declaration executed by joint inventors Dielhof and Centen, the surcharge, and the instant petition with required fee were filed.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Rule 47 applicants have failed to show that the inventor cannot be reached. Where inability to find or reach a nonsigning inventor is alleged, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the nonsigning inventor. The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted.

No one with first hand knowledge has made a declaration/statement of facts as to the circumstances that show the inventor cannot be found. The e-mails and other correspondence between Philips employees and the letter addressed to Mr. Morrison at his last known address are

pieces of non-conclusive evidence that tend to show attempts were made to reach Mr. Morisson at his last known address.¹ There is no other evidence that establishes petitioners' diligence in locating him. Petitioners must attempt to find Mr. Morisson through means other than attempting to contact him at his last known address. Copies of documentary evidence such as certified mail return receipt, any inquiries of the Caen telephone directory, or any extant national or regional registry, telegrams, and print-outs of internet searches that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Pursuant to petitioners' authorization, deposit account no. 14-1270 will be charged the \$130.00 petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petition
E. Shirene Willis, Petitions Attorney

By hand: Office of Petitions
2201 South Clark Place
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Telephone inquiries should be directed to the undersigned at (703) 308-6712.



E. Shirene Willis
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ Mrs. Laublin states that she sent a reminder to Richard Morisson on October 26, 2001 and that it was returned. This is evidence that argues in favor of petitioners' inability to reach Mr. Morisson. Regarding Mrs. Lanslots' letter of July 23, 2001, petitioners have not provided a statement from Mrs. Lanslots that she mailed the correspondence. In addition, the Office has no information as to whether it was returned to sender.